

REMARKS

Claims 1-9, 13, and 15 are currently pending in this Application. Claims 1 and 4 are amended with this Response.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1 and 4-5 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,631,887 to Francovitch (hereinafter referred to as “Francovitch”). Applicant respectfully traverses.

Applicant notes that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant’s amended claims 1 and 4 recite *inter alia*:

“said at least two pieces including a second piece that is affixed to a relative top of said first piece, *wherein said second piece covers a substantially entirety of said first piece, and wherein said fastener is disposed entirely out of contact with said second piece.*”

Francovitch does not teach a second piece of energy absorbing material that covers a substantial entirety of a top surface of a first piece. On the contrary, referring to Column 5, line 42 and Figures 1 and 3, Francovitch teaches a second piece (i.e. head 33) that includes a passage 34, the passage 34 being configured for insertion of the first piece 40 (i.e. insert 40). Since the first piece 40 is inserted through the top of second piece 33, there is no material present at the top of 33 to cover the top surface of 40. As such, Francovitch fails to teach a second piece of energy absorbing material that covers a substantial entirety of a top surface of a first piece, as recited in Applicant’s amended claims 1 and 4.

Francovitch also does not teach a fastener that is disposed entirely out of contact with said second piece. On the contrary, referring to Column 6, lines 59-69 and Figure 1, Francovitch

teaches a second piece 33/30 which is “secured to the roof structure by a linear fastener 75” via an “engaging” of the head 76 with the shoulder of the second piece 33/30. As such, the second piece 33/30 of Francovitch clearly contacts the fastener 75, and Francovitch fails to teach a fastener that is disposed entirely out of contact with said second piece., as recited in Applicant’s amended claims 1 and 4.

For at least the above reasons, Applicant respectfully asserts that Francovitch does not teach every element of claims 1 and 4. Accordingly, Applicant respectfully submits that claims 1, 4, and 5 are not anticipated by Francovitch.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-6 and 9 are rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,441,295 to Kelly (hereinafter referred to as “Kelly”) in view of U.S. Patent No. 4,841,706 to Resan (hereinafter referred to as “Resan”) and U.S. Patent No. 5,204,148 to Alexander (hereinafter referred to as “Alexander”). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant’s amended claims 1 and 4 recite *inter alia*:

“energy absorbing material that are non-metallic...said at least two pieces including a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of a top surface of no other roofing component.”

None of Kelly, Resan, or Alexander, taken alone or in combination, teach a first piece of energy absorbing material that is *non-metallic* and positioned and dimensioned to directly contact said top of said fastener. At page 4 of the Office Action, the Examiner uses Resan to allegedly teach a first piece 18 of energy absorbing material that directly contacts a fastener 28. However, referring column 3, lines 51-52, Resan teaches the layer 18 to be an induction heating element in the form of metal wire or metal screen. As such, Resan fails to teach a non-metallic first piece (as is now required by Applicant's claims). In addition, if one were to suggest, *pro arguendo*, modifying the metal heating element 18 of Resan to be a non-metallic material, the induction heating properties and abilities of element 18 (see column 4, lines 7-24) would be lost, and Resan would be rendered inoperable for its intended purpose. Accordingly, such a potential modification would be improper under MPEP 2143.01V.

In addition, none of Kelly, Resan, or Alexander, taken alone or in combination, teach a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is positioned and dimensioned to cover *a substantial entirety of a top surface of no other roofing component*. On the contrary, Kelly does not teach a first piece, Alexander teaches a first piece 3 that covers all of washer 25, and Resan teaches element 18 to cover at least a substantial entirety of the top surface of the base plate 12.

For at least the above reasons, Applicant respectfully submits that *prima facie* obviousness does not exist over claims 1-6 and 9 with regards to Kelly, Resan, and Alexander.

Claims 7 and 8 are rejected under 35 U.S.C. §103(a) as being obvious over Kelly in view of Resan and Alexander. Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re*

Wilson, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 7 and 8 depend from claim 4. Thus, for at least the reasons discussed above, the proposed combination of Kelly, Resan, and Alexander fails to teach every element of Applicant's claims 7 and 8. As such, *prima facie* obviousness does not exist over claims 7 and 8 with regards to Kelly, Resan, and Alexander.

Claim 13 is rejected under 35 U.S.C. §103(a) as being obvious over Kelly in view of Resan. Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant's amended claim 13 recites *inter alia*:

“energy absorbing material that are non-metallic...said at least two pieces including a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is positioned and dimensioned to cover a substantial entirety of a top surface of no other roofing component.”

Neither Kelly nor Resan, taken alone or in combination, teach a first piece of energy absorbing material that is *non-metallic* and positioned and dimensioned to directly contact said top of said fastener. At page 4 of the Office Action, the Examiner uses Resan to allegedly teach a first piece 18 of energy absorbing material that directly contacts a fastener 28. However, referring column 3, lines 51-52, Resan teaches the layer 18 to be an induction heating element in the form of metal wire or metal screen. As such, Resan fails to teach a non-metallic first piece (as is now required by Applicant's claims). In addition, if one were to suggest, *pro arguendo*,

modifying the metal heating element 18 of Resan to be a non-metallic material, the induction heating properties and abilities of element 18 (see column 4, lines 7-24) would be lost, and Resan would be rendered inoperable for its intended purpose. Accordingly, such a potential modification would be improper under MPEP 2143.01V.

In addition, neither Kelly nor Resan, taken alone or in combination, teach a first piece that is positioned and dimensioned to directly contact said top of said fastener, such that said first piece is positioned and dimensioned to cover *a substantial entirety of a top surface of no other roofing component*. On the contrary, Kelly does not teach a first piece and Resan teaches element 18 to cover at least a substantial entirety of the top surface of the base plate 12.

For at least the above reasons, Applicant respectfully submits that *prima fascia* obviousness does not exist over claim 13 with regards to Kelly and Resan.

Claim 15 is rejected under 35 U.S.C. §103(a) as being obvious over Kelly in view of Resan and Alexander. Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contains some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 15 depends from claim 13. Thus, for at least the reasons discussed above, the proposed combination of Kelly, Resan, and Alexander fails to teach every element of Applicant's claim 15. As such, *prima fascia* obviousness does not exist over claim 15 with regards to Kelly, Resan, and Alexander.

Conclusion

All of the rejections are herein overcome. No new matter is added by way of the present Remarks, as support is found throughout the original filed specification, claims, and drawings. Notice of Allowance is respectfully requested.

If the Examiner has any questions regarding the instantly submitted response, Applicant's attorney respectfully requests the courtesy of a telephone conference to discuss any matters in need of attention.

Applicant hereby petitions for any necessary extension of time required under 37 C.F.R. 1.136(a) or 1.136(b) which may be required for entry and consideration of the present Reply.

If there are any additional charges with respect to this response or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,
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